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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/835,732	04/11/1997	DEAN A. KLEIN	MPAT.172A	5441
20995	7590	12/16/2003	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			NGUYEN, DUNG T	
			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/835,732

Applicant(s)

KLEIN, DEAN A.

Examiner

Dung Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/03/2003 has been entered.
2. Applicant's amendment dated 09/22/2003 has been received and entered.
3. By the amendment, Claims 1, 2, 4-9, 11-13 and 15-20 are now pending in the application.

#### ***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 1, 16-17, 20 recite a limitation of "the transmissive material provides a casing and structure support for handling by a user" which is not disclosed in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 1-2, 4-9, 11-13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 16-17 and 20, they have been contained the material which is not supported by the original disclosure as stated above. Such amendment does not have basis in the original disclosure and fails to comply with the written description requirement. Therefore, the added such limitation constitutes a new matter.

Applicant is required to cancel the new matter in the reply to this Office action or it must be re-filed as a continuation-in-part of the parent application with a new oath/declaration.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-2, 4-9, 11-13 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 16-17 and 20, it is confusing and unclear how a transmissive material can provide a casing and structure support for handling by a user. According to the specification and drawing (figure 1), the transmissive material has to be coated by a reflective layer and such combination would provide a casing and structure support for handling by a user. In other words, a transmissive layer, by itself, cannot provide a casing and structure support for

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handling as claimed. Correction to the language is suggested to clarify the claimed subject matter.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-2, 4-5, 7, 11, 15-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiyama et al., U.S. Patent No. 5,548,271.

Regarding claims 1-2, 15-16 and 20, for the best understanding, Tsuchiyama et al disclose a data display pager which as understood is a computerized device. In the embodiment as described at column 3 and shown in figures 4 and 3B, the pager comprises a LCD display panel (12); a housing having a reflecting frame (36) and a light conducting plate (38) wherein the frame and the plate are formed integrally with each other; a set of light emitting diodes (12a, 12b) being substantially enclosed by the openings (38a, 38b) of the light conducting plate (38). As a result, the light conducting plate (38) guides light from the light emitting diodes (12a, 12b) to the LCD display panel (12) and simultaneously acts as a protecting element for the LCD display panel. Regarding to the feature of "a LCD housing made in a single light transmissive material" having a reflective coating thereon recited in the claims 1, 16-17 and 20, such a feature is readable from the structure of the reflection frame (36) provided in figure 4 by Tsuchiyama et al.. Applicant should be noted that any kind of reflector or reflecting element is a combination of

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at least two layers in which one layer is a layer of transmissive material and the other is a layer of reflective material and it was decided in the Courts that a formation in one piece an article which has formerly been formed in two pieces and vice verse involves only routine skill in the art. See Howard v. Detroit stove works, 150 U.S. 164; Nerwin v. Erlichman, 168 USPQ 177, 179.

Regarding claim 17, the pager provided by Tsuchiyama et al as described above meets all of the features concerning the components being used as well as the structural relationship among the components except that Tsuchiyama et al do not clearly set forth a method or set of steps for conducting light as claimed. However, it would have been obvious to one skilled in the art at the time the invention was made to design a method or set forth a sequence of steps including the step of using a set of light emitting diodes (12a, 12b) for generating light, and a step of using a light conducting plate (38) for guiding light from the diodes to illuminate a LCD display panel (12).

Note: *It should also be noted that, according to the specification and drawing, the display page having a transmissive material (32 in figure 3B or 38 in figure 4) provide inside a reflective frame (36) would be the same as an LCD housing having a transmissive material with a reflective coating to provide a case and a structure support for handling in the application.*

Therefore, the limitation of the above claims met.

12. Claims 6, 9, 12-13 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiyama et al in view of Applicant's admitted prior art figure 2 as applied to claims 1 and 3 above, and further in view of Habing et al (U.S. Patent No. 5,661,578, of record).

The combined product as provided by Tsuchiyama et al and the prior art as described above meets all of the limitations of the device as claimed in claims 6, 9 and 12-13 except the type of the light emitting elements being used. In other words, while Tsuchiyama et al teach the use of light emitting diodes as light emitting elements, they do not clearly state that other type of light emitting element such as a cold cathode fluorescent lamp can be used for generating light. However, the use of different light emitting elements for providing light in an optical device wherein the light emitting elements can be light emitting diode or cold cathode fluorescent lamp is clearly known to one skilled in the art as disclosed by Habing et al in their LCD device. See Habing et al, column 5, lines 27-34. Thus, it would have been obvious to one skilled in the art at the time the invention was made to use any suitable illuminating elements including a cold cathode fluorescent lamp in lieu of a light emitting diode as suggested by Habing et al for the purpose of providing light to illuminate a LCD display panel in a particular design.

With regard to the method steps as recited in present claims 18 and 19, it would have been obvious to one skilled in the art to utilize the combined product as described above by design a method or set forth a sequence of steps including the step of using a set of light emitting diodes (12a, 12b) for generating light then a step of using a light conducting plate (38) for guiding light from the diodes to illuminate a LCD display panel (12), and making the outer surface of the light conducting plate as a reflecting element for the purpose of reflecting light from the light conducting plate back to the LCD display panel .

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiyama et al in view of Applicant's admitted prior art, figure 2 as applied to claim 4 above and with or without Ohno et al (U.S. Patent No. 5,128,781, of record).

The combined product as described above meets all of the limitations of the device as claimed in claim 8 except the feature concerning the arrangement of the light illuminating element, the housing and the LCD display panel. However, an arrangement of the light illuminating element in a gap defined by the housing and the LCD as claimed is merely that of a preferred embodiment and no criticality has been disclosed. The support for this conclusion is found in the present specification in which applicant has taught that the LCD is located in an adjacent manner with respect to the housing while the light emitting elements are coupled to the housing. Such an arrangement is indeed claimed as can be seen in the present claim 5. Further, the arrangement of light emitting element in a central section of a light conducting plate which is separated from a LCD display panel by a gap is clearly suggested in the art as can be seen in the LCD device provided by Ohno et al. See columns 2-3 and figure 1. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art to rearranging the positions of the optical components in an optical device including the arrangement of the light emitting elements in a light conducting plate which is separately located from a LCD as suggested by Ohno et al for the purpose of illuminating the LCD. See also *In re Japikse*, 86 USPQ 70 (CCPA 1950).

***Response to Arguments***

11. Applicant's arguments filed 09/22/2003 have been fully considered but they are not persuasive as stated above.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Nguyen whose telephone number is 703-305-0423. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 703-305-3492. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

*DN*  
*12/12/2003*



***Dung Nguyen***  
***Patent Examiner***  
***Art Unit 2871***